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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/681,788

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Donald T. Tang

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03/25/2005

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EXAMINER

BAKER, CHARLOTTE M

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,788

Applicant(s)

TANG ET AL.

Examiner

Charlotte M Baker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-18 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Response to Arguments

1. Applicant's amendment to the specification filed on 01/20/2005 at p. 8, par. 48 is acknowledged and the objection to the specification is hereby withdrawn.
2. Applicant's amendment filed on 01/20/2005 regarding the objection to claims 1 and 11 is acknowledged, and the objection to claims 1 and 11 is hereby withdrawn.
3. Applicant's amendment filed on 01/20/2005 regarding the 35 USC § 112, second paragraph rejection of claims 5 and 8 is acknowledged and the rejection is hereby withdrawn.
4. Applicant's arguments filed 01/20/2005 with respect to the rejections of claims 9, 10, and 12 under 35 USC § 102(b) have been fully considered but they are not persuasive.
5. In response to applicant's argument that the references fail to show certain features of applicant's invention (see Applicant's remarks, p. 11, regarding the rejection of claims 9, 10, and 12) it is noted that the features upon which applicant relies (i.e., "selected area is a portion of the writing area"; "writing area may be the size of a sheet of paper"; "dialing area is defined as a region of (or adjacent to) a page being faxed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
6. Given that Applicant has not proposed an argument with respect to the deficiencies of Hoghooghi et al. in the rejection of claims 1-4, 6-8, and 11 under 35 USC § 103(a), Examiner is addressing the rejections as best understood. Applicant alleges that the stylus, digitizer and separate small display of Hoghooghi et al. add nothing to the teaching of Blakeslee. Examiner respectfully traverses Applicant's comments. Hoghooghi et al. is relied upon in separate

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instances in the claim rejections of claims 1-4, 6-8, and 11 and 12 to teach subject matter which is not specifically addressed by Blakeslee. In addition, the Blakeslee and Hoghooghi et al. references are drawn to similar fields of endeavor; therefore, they are combinable. Hoghooghi et al. cures the deficiencies of Blakeslee as outlined in the claim rejections of claims 1-4, 6-8, and 11.

7. Applicant's arguments, see p. 12, regarding the rejection of claim 5, filed 01/20/2005, with respect to the rejection of claim 5 have been fully considered and are persuasive. The 35 USC § 103(a) of claim 5 has been withdrawn.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application (98123077.6) filed in China on 12/07/1998. It is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

Allowable Subject Matter

9. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 9, 10, 12 and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Blakeslee (GB 2308523 A).

Regarding claim 9: Blakeslee discloses selecting an area on a writing area (screen 12) of an input device (pocket-sized mobile telephone device 10) as a dialing area (display 12A); loading a program for defining the dialing area (a microprocessor is inherent in a mobile telephone and coordinates the functions [dialing area] of the mobile telephone device and handles command and control signaling. The program(s) for the device is/are contained within this microprocessor); processing the signal coming from the dialing area (encoded and converted, p. 15, ln. 8-14); triggering the program (microprocessor function) according to predetermined timing (also a microprocessor function) when a writing device (stylus 13) contacts the dialing area (screen 12). Once the stylus 13 contacts the dialing area (screen 12), a sequence of events is set into motion. The handwritten message is encoded and converted in the device 10 and processed as a facsimile transmission (p. 15, ln. 1-22).

Regarding claim 10: Blakeslee discloses a device 10 and a computer program product (ROM, inherent to device 10). The computer readable code is contained in ROM and is then executed by the microprocessor. All the method steps discussed in the rejection of claim 9 are applicable in claim 10.

Regarding claim 12: Elements discussed in the rejection of claim 9 are applicable to claim 12. Since the device 10 inherently contains a microprocessor (CPU), the device 10 is a computer system.

Regarding claims 13-18: Because Blakeslee teaches that the input image is converted to a fully sized (interpreted as a standard size) fax document (note p. 12, last par. through p. 13, 1st par.), it

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is inherently taught that the writing area has a for factor coinciding with a standard paper size.

Further, since Blakeslee teaches part images 21-1 and 21-2 (note p. 15, 1st par.) it is inherently taught that the dialing area is defined as a region of a page being faxed (claims 13, 15, and 17), a region adjacent a fax page display area of said writing area (claims 14 and 18), and a region adjacent to a fax page display area (claim 16).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 6-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blakeslee in view of Hoghooghi et al. (5,959,260).

Regarding claim 1: Blakeslee discloses a pen-based input device (pocket-sized mobile telephone device 10) comprising a writing pen (stylus 13) and a writing pad (screen 12) enabling a user to write documents for fax transmission (facsimile document 21) on the writing pad (screen 12) by means of the writing pen (stylus 13); an encoder (encoded and converted in the device 10, p. 15, ln. 4) for transferring the stroke format data representative of the moving trace of the writing pen into fax data format (G3 fax data format, p. 15, ln. 5-6); a dialer (display 12A on the touch-sensitive display screen 12) for inputting the fax number of a destination to set up a connection herewith; a fax transmission device (facsimile transceiver 20) for transmitting to the destination the data in the fax data format output from the encoding means (Fig. 3).

Blakeslee fails to specifically address the operating function of the stylus pen.

Hoghooghi et al. disclose an input device (cellular telephone 100) capable of generating data representative of the moving trace of the pen-based input device (cellular telephone 100) and of recording a user's written input (handwritten information, col. 5, ln.. 46-50) in a strokes data format, each stroke comprising a series of position coordinates of pen-based input device between a pen-down event and a pen-up event (x, y coordinates, col. 5, ln.. 63-67 through col. 6, ln.. 1-12). It would have been obvious for a person of ordinary skill in the art to use a stylus pen in conjunction with a handwriting recognition engine 560 in order to allow high recognition accuracy to be achieved for a particular user as suggested by Hoghooghi et al. (col. 6, ln.. 36-37).

Regarding claim 2: Blakeslee in view of Hoghooghi et al. satisfy all the elements of claim 1.

Hoghooghi et al. further disclose a handwriting digitizer (digitizer 112).

Regarding claim 3: Blakeslee in view of Hoghooghi et al. satisfy all the elements of claim 1.

Hoghooghi et al. further disclose a device integrating a handwriting digitizer with a traditional paper-based record making system (enables a user to enter handwriting, gestures, commands, or annotations, col. 2, ln.. 32-36).

Regarding claim 4: Blakeslee in view of Hoghooghi et al. satisfy all the elements of claim 1.

Hoghooghi et al. disclose a data filter (sensor 554) for filtering the data generated by the pen-based input device to extract the stroke data represented by x and y coordinates. Blakeslee discloses a format generator (encoding and converting, p. 15, ln.. 1-14) for transferring the stroke data into data in the standard fax data format (G3 fax data format) by interpolating, sorting and encoding.

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Regarding claim 6: Blakeslee in view of Hoghooghi et al. satisfy all the elements of claim 1.

Blakeslee further discloses dialing means (display 12A) provided in the writing pad (screen 12) in the form of a keyboard.

Regarding claim 7: Blakeslee in view of Hoghooghi et al. satisfy all the elements of claim 1.

Blakeslee further discloses a dialing means (making an outgoing call, p. 12, ln. 16 and addressing a recipient, p. 15, ln. 8-14) provided in the writing pad (screen 12) in the form of a software-defined dialing area comprising selectable buttons displayed in a GUI (display 12A) in the writing pad (screen 12) and program code responsive to selection of one of said buttons by the writing pen (display 12A on the touch-sensitive display screen 12).

Regarding claim 8: Blakeslee in view of Hoghooghi et al. satisfy all the elements of claim 1.

Blakeslee further discloses an interface (image store and forward unit SF) for archiving fax documents (store 52) and accepting the fax template defined by the user (receiver 51 and transmitter 53) (p. 17, ln. 18-36 through p. 18, ln. 1-7).

Regarding claim 11: Elements discussed in the rejection of claim 1 are applicable to claim 11.

Since the device 10 inherently contains a microprocessor (CPU), the device 10 is a computer system.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M Baker whose telephone number is (703) 306-3456. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER


cmb